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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,484	12/11/2001	Achim Franck	tesa AG 1510-WCG	1006
27386	7590	04/06/2004	EXAMINER	
WILLIAM GERSTENZANG NORRIS, MCLAUGHLIN & MARCUS, P.A. 220 EAST 42ND STREET, 30TH FLOOR NEW YORK, NY 10017			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 2/2/04
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1, 3-13, 15-18 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 3-13, 15-18 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☒ The ~~proposed~~ drawing correction, filed on 2/23/04 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention, substantially for the reasons set forth in paragraph No. 3 of Paper No. 6, together with the following additional observations. While the Examiner notes that applicants agree with his earlier position that the "average roughness  $R_a$ " and "average depth of roughness  $R_z$ " are defined by the reference test standard DIN 4768, they must note that to date the following documents set forth at the bottom of page 9 and continuing onto page 10 of applicants' Response relating to this particular issue are unfortunately nowhere to be found in the electronic application file. Additionally, the Examiner further notes that applicants' cancellation of Figure 2A in Example B appears to have taken a critical section of the disclosure necessary to understand the invention out of the application file, and accordingly the Examiner must hold that the specification in its present form is still clearly non-enabling.

3. Claims 1, 3-13 and 15-18 are rejected under 35 U.S.C. §

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112, first paragraph as being based upon a non-enabling specification.

4. The Examiner notes that although the 35 U.S.C. § 112, second paragraph rejections of record appear to have been overcome, there are still spelling errors with respect to "adjacet" in claim 7, line 2, "disapp ars" in claim 11, line 3, and "rel ase" in line 1 of claim 18; these minor informalities should be corrected.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

6. A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-13 and 15-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lühmann et al. -397, substantially for reasons set forth in paragraph No. 8 of Paper No. 6, together with the following additional observations. Upon reconsideration, the Examiner believes that Lühmann et al. -397 is also an inherent anticipation of both applicants' broad claims, and at least several of the dependent claims, since the

average roughness parameter  $R_a$  range is believed to be inherent in at least certain embodiments of the disclosed genus of embodiments, or alternatively, at most an obvious optimization to one of ordinary skill. Note that while the reference is generally directed to "low stick and slip friction with respect to the adhesive film strip" (Abstract) it is more directed to how to adjust the frictional coefficients so as to obtain the desired frictional, i.e. roughness characteristics, which are selected for the claimed article. Additionally, although applicant argues extensively (Response page 11) concerning the various alleged differences between what the reference discloses and what his invention is focused upon, to date no such evidence which would back his definition of the average roughness  $R_a$  or the test DIN 4768 have been introduced into the application file. As such, the Examiner must specifically object to applicants' characterization in the next to last paragraph on page 11 which while stating that "nothing in the -397 reference teaches or suggests anything at all about the desirability of a specific degree of surface roughness  $R_a$ , or indeed, even recognizes the concept of average roughness  $R_a$ " appears to have overlooked the central element of the Examiner's position, namely that selecting and choosing a specific degree of surface roughness is not only believed to be inherently disclosed in the reference, but also is

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well within the ordinary skill of the art. Note again Lühmann et al. -949 or -665, each previously cited as evidence of the state of the art, which disclose redetachable adhesive tapes taken from essentially the identical art as that of the claimed invention, and further disclose the relationship between rough or smooth surfaces and their resulting adhesive bond area strength and other related frictional parameters. In summary, applicants cannot be seen to have rebutted the prima facie case of record.

8. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE

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STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

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March 31, 2004

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1300~~  
1700

*Daniel Zinker*